21

FILED
MAY 16 19
CHARLES ELMORE CR

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1945

NO. 1233

THE E. L. ESSLEY MACHINERY COMPANY,
an Illinois Corporation,
Petitioner,

vs.

THE DELTA MANUFACTURING COMPANY,
a Delaware Corporation,
Respondent.

PETITION FOR A WRIT OF CERTIORARI
To the Circuit Court of Appeals
For the Seventh Circuit, and
BRIEF IN SUPPORT THEREOF.

JOHN W. MICHAEL,
GERRIT D. FOSTER,
Counsel for Petitioner.

HANNERSMITH-KORTHEYER CO. MILWAUKEE

INDEX

	Page
Petition	1
Summary and Short Statement of the Matter Involved	2
The Gravamen	2
The Alleged Invention	3
The Prior Art	4
The Findings and Decisions of the Courts Below	7
Reasons Relied upon for the Granting of a Writ of Certiorari	8
Brief in Support of Petition	11
The Opinions of the Courts Below	11
Jurisdiction	11
Statement	11
Specification of Errors	11
Summary of Argument	12
Argument	12

Authorities Cited

Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., 294 U.S. 477, 487	8, 11, 12
American Road Machine Co. v. Pennock and Sharp Company, 164 U.S. 26	9
Ansonia Co. v. Electrical Supply Co., 144 U.S. 11, 18	15
Concrete Appliances Co. et al. v. Gomery et al., 269 U.S. 177	9

Page

Cuno Engineering Corporation v. Automatic Devices Corp., 314 U.S. 84, 91 15

Dow v. Halliburton, 65 S. Ct. 647, 650; 324 U.S. 320 15

Electric Cable Joint Co. v. Brooklyn Edison, 292 U.S. 69, 79 ..... 9, 18

Ford Motor Co. v. Parks & Bohne, C.C.A. 6th, 21 Fed. (2d) 943, 946 16

General Electric Co. v. Wabash Appliance Corporation, 304 U.S. 364, 369 ..... 8, 9

Grinnell Washing Machine Co. v. Johnson Co., 247 U.S. 426, 433-4 ..... 9, 17

Grosjean et al v. Panther-Panco Rubber Co., Inc., C.C.A. 1st, 113 Fed. (2d) 252, 256 16

Hookless Fastener Co. v. G. E. Prentice Mfg. Co., C.C.A. 2nd, 68 Fed. (2d) 940, 941 16

Lincoln Co. v. Stewart-Warner Corp., 303 U.S. 545, 546 11

McCarty v. Lehigh Valley R. R. Co., 160 U.S. 110, 116 ..... 8, 13, 16

Mercoid Corporation v. Mid-Continent Investment Co., 320 U.S. 661, 665 ..... 9, 19

Milcor Steel Co. v. George A. Fuller Co., 316 U.S. 143, 145 ..... 8, 13

Morton Salt Co. v. Suppiger Co., 314 U.S. 488, 490.. 11

Pennsylvania Railroad Company v. Locomotive Truck Co., 110 U.S. 490, 494-496 15

Phillips v. Page, 24 How. 164, 167 15

Potts v. Creager, 155 U.S. 597, 608 15

Page

Powers-Kennedy Contracting Corporation, et al v. Concrete Mixing and Conveying Co., 282 U.S. 175, 180, 186 ..... 9, 18

Roberts v. Ryer, 91 U.S. 150, 157 15

Schriber Co. v. Cleveland Trust Co., 311 U.S. 211, 217 11

Sinclair & Carroll Co. v. Inter-Chemical Corp., 65 S. Ct. 1143, 1145; 325 U.S. 327 9

Stearns v. Russell, 85 Fed. 218, 224, C.C.A. 6th, certiorari denied 171 U.S. 689 16

United Carbon Company v. Binney & Smith Co., 317 U.S. 228, 232 9

White v. Dunbar, 119 U.S. 47, 52 19

Williams Manufacturing Co. v. United Shoe Machinery Corp., 316 U.S. 364, 365 9

Statutes

Judicial Code, Sec. 24(7); 28 U.S.C. 41(7) 11

Judicial Code, Sec. 240(a) as Amended, 28 U.S.C. 347 11

Sec. 4888, R.S.; U.S.C. Title 35, Sec. 33 18

Textbook

Walker on Patents, Deller's Ed., Vol. II, Sec. 274, Page 1271 16

Rule

Rule 38 1

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1945

NO.

THE E. L. ESSLEY MACHINERY COMPANY,
an Illinois Corporation,
Petitioner,

VS.

THE DELTA MANUFACTURING COMPANY,
a Delaware Corporation,
Respondent.

PETITION FOR A WRIT OF CERTIORARI
To the Circuit Court of Appeals
For the Seventh Circuit.

To the Honorable The Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your Petitioner, The E. L. Essley Machinery Company, respectfully prays for a writ of certiorari to the Circuit Court of Appeals for the Seventh Circuit to review a judgment of that Court, entered February 28, 1946 (R. 314). A certified transcript of record, including the proceedings in the Circuit Court of Appeals, has been filed herein pursuant to Rule 38.

I. SUMMARY AND SHORT STATEMENT OF THE MATTER INVOLVED.

This is a suit for the infringement of claims 6, 7 and 8 of Letters Patent No. 2,069,395, dated February 2, 1937 (R. 239), relating to a "safety shield". The District Court held the claims valid and infringed and ordered an injunction and an accounting (R. 221, 308). The Circuit Court of Appeals affirmed (R. 314). A petition for rehearing was filed (R. 317) and denied (R. 331).

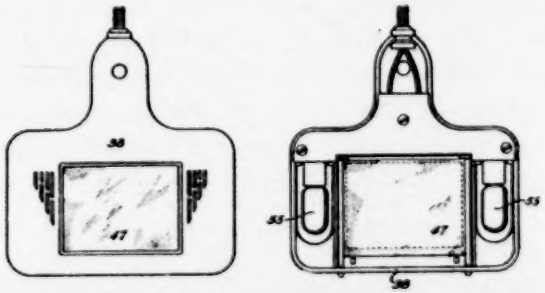
Petitioner concedes infringement if the claims are valid. **Petitioner does not seek a retrial of the facts, merely a proper application of the law to the facts.**

The Gravamen: Having regard to the alleged **invention defined in the claims** of the patent in suit, both decisions and all findings below are utterly irrelevant and fail to support the ultimate conclusions of invention and validity. **There is no correspondence between the invention claimed and the facts found.**

The patented device, *as defined by the claims,* is a safety shield or viewing device comprising a frame or housing having a central opening therein, a transparent panel for the opening, lamp compartments adjacent opposite sides of the transparent panel, and lamps in the compartments. The patent points out that the lamps adjacent opposite sides of the transparent panel afford "shadowless illumination" of work viewed therethrough. The prior art contains viewing devices which squarely anticipate the claims. These prior art devices have all of the claimed elements arranged and functioning in precisely the same way and producing precisely the same result. The claims read squarely upon them. In substance they are identical.

The courts below disregarded the plain language of the claims and interpreted them as including elements not recited therein, namely, a grinding machine and a special mounting of the viewing device thereon in relation to the grinding wheel thereof. They considered the advantages which existed only when the shield was so mounted and employed, and relying on those advantages brushed aside the prior art and held the claims valid. Thus there was upheld as an invention a relationship between a grinding wheel and an illuminating viewing device which relationship was neither claimed nor patented. This is contrary to and in direct conflict with the settled law of this Court. It also works hardship and injury to the public, for the patent will not expire until February, 1954.

The Alleged Invention: Two illustrations of the device of the patent are reproduced at this point, a top view (left), and an inverted view (right), the parts indicated by reference numerals being specified in the footnote[1]:



While the patent discloses an application of the device to a grinding machine, the patentee in his specification states (R. 240, 2nd col. ls. 52-4), "While the safety shield

[1] 38—housing or support; 47—transparent viewing panel or window; 55—lamps beneath housing, one on either side of window.

is here shown to be applied to a grinder it may also be applied to other machines or devices", and the claims contain no recital or reference of any kind or nature to a grinding machine or to the combination of the device with or the mounting or application thereof to or upon a grinding machine. Furthermore, Respondent has granted a license under the patent under which the licensee makes and sells the shield to dentists, dermatologists and surgeons (R. 203-5) for uses having no relation whatever to grinding.

The claims in suit recite "a safety shield comprising a housing" (claim 6), or "a safety shield comprising a support" (claims 7 and 8) having a transparent viewing panel or window, lamps beneath the housing or support, one on either side of the window. Claim 6 is typical.[2]

A shield comprised of these elements constitutes the whole of the alleged invention as set forth in the claims.

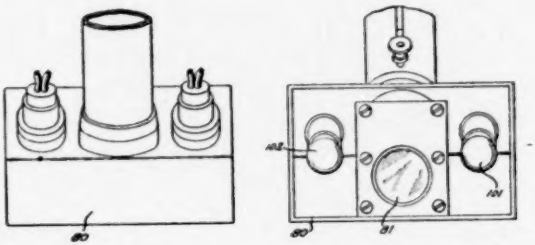
The Prior Art: The use of two or more lamps in shields or viewing devices to provide shadowless illumination of an object or work viewed through a central window in the top wall of the device was old in the art long prior to the alleged invention of the patent in suit.

Following are two views of one of these prior art shields (Jones R. 289), a top view (left), and an inverted view (right), the parts indicated by reference

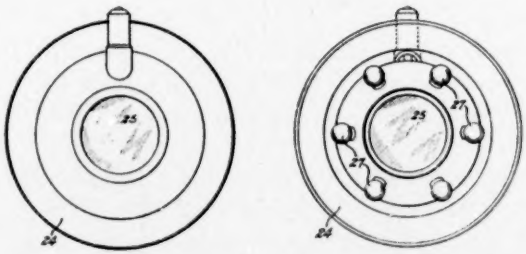
---

[2] 6. A safety shield comprising a housing having a top wall and a skirt, said top wall having an opening, a transparent panel for said opening for viewing work therethrough, and means carried by said housing for directing light onto the work from regions adjacent the opposite sides of said panel and within said skirt.

numerals being specified in the footnote[3]:



Two views of another of these prior art shields (Lindsay R. 297) are reproduced at this point, a top view (left), and an inverted view (right), the parts indicated by reference numerals being specified in the footnote[4]:



The device of the patent is a substantial copy of these prior art shields. In substance they are identical. In the Jones shield two lamps are employed, one on each side of the viewing panel affording shadowless illumination of an object or work viewed through the device. In Lindsay six lamps are mounted in the shield and spaced equidistantly around the viewing opening to provide the shadowless illumination.

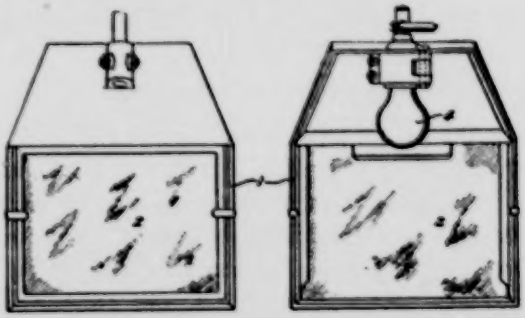
---

[3] 80—housing or support; 81—transparent viewing panel or window; 101, 102—lamps beneath the housing, one on either side of window.

[4] 24—housing or support; 25—transparent viewing panel or window; 27—lamps beneath housing entirely surrounding window.

The Jones shield is shown applied to a cutting machine. The Lindsay shield is not shown applied to any particular use or machine, but the patent (R. 297, ls. 7-10) states: "the present invention is especially adapted for use by mechanics, watch makers, and artisans of various kinds where fine work is involved," and (R. 298, ls. 129-131) "that others can by applying current knowledge readily adapt it for various applications."

It was also old in the art long prior to the alleged invention of the patent in suit to mount on grinding machines safety shields of the precise character and construction set forth in the patent in suit with the single exception that in these earlier grinding wheel safety shields a lamp on but one side of the viewing window was employed (R. 163-179, incl.). Two views of one of these prior art safety shields (Boys Tech. R. 179) are reproduced at this point, a top view (left), and an inverted view (right), the parts indicated by reference numerals being specified in the footnote[5]:



Save for the second lamp on the opposite side of the viewing window, this safety shield embodies every element of the claims in suit.

[5] 1—housing or support; 2—transparent viewing panel or window; 4—lamp beneath housing on one side of window.

Not a single item of this prior art is in dispute. The disclosures are clear and unequivocal.

The Findings and Decisions of the Courts Below: The Court of Appeals made no analysis of the claims in suit, but treated them throughout as though they included or were directed to the combination of the shield with a grinding machine which is entirely foreign to the combination or structure defined by the claims. The Court pointed out at length (R. 310) the rigidity of the mounting of the shield upon a grinding machine to avoid vibration, the positioning of the light bulbs at the sides of the shield out of the line of particles thrown off from the grinding wheel, the permanent mounting of the shield close to the grinding wheel so that it cannot be thrown back, and then detailed the history of grinding machine shields, the use of goggles, the practice of throwing the old shields back out of the way as compared to the permanent mounting of the shield of the patent. The lower court viewed the matter in the same light and made specific findings (R. 214) concerning the grinding machine adaptation of the device in support of the holding of validity. ***There is nothing in any of the three claims in suit on which to base any such findings. All are entirely foreign to the claims.***

Save for findings relating to such matters as parties, jurisdiction, title, conduct of defense, and the like, and the ultimate findings or conclusions of validity and invention, all facts found and all opinions expressed by the lower courts treat of the invention in terms of grinding.

The Court of Appeals rejected the single lamp safety shields because they incorporate but one lamp (R. 312). It rejected the Jones shield because it is shown applied to a cutting machine (R. 313), despite the fact that the specification of the patent in suit expressly points out

that the shield of the patent is not limited to grinders but may also be applied to other machines and devices, and despite the fact that the claims do not even mention grinding machines or the manner of mounting the support or housing, fixedly or otherwise. The patentee sought and obtained claims to a safety shield for general application or adaptation. The Court rejected the Lindsay device because it employs a transparent panel or window of magnifying glass (R. 313), despite the fact that Respondent's licensee makes and sells under the patent a viewing device (R. 203-5) employing a transparent panel or window of magnifying glass in no way related to the grinding machine art, and further, despite the fact that the claims merely call for a "transparent panel", a term equally descriptive of a window whether of magnifying or plain glass.

II. REASONS RELIED UPON FOR THE GRANTING OF A WRIT OF CERTIORARI.

The discretionary power of this Court is invoked upon the following grounds:

1. Because the decisions of the courts below are contrary to and in direct conflict with the decisions of this Court in *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U.S. 477, 487; *Milcor Steel Co. v. George A. Fuller Co.*, 316 U.S. 143, 145; *General Electric Co. v. Wabash Co.*, 304 U.S. 364, 369; *McCarty v. Lehigh Valley R. R. Co.*, 160 U.S. 110, 116; all to the effect that it is the claims, not the specifications, which afford the measure of protection of the grant and that the claims of a patent cannot be aided by reading into them parts of the specifications which the patentee failed to include in them.

2. Because the decisions of the courts below are contrary to and in direct conflict with the decisions of this Court in *Grinnell Washing Machine Co. v. Johnson Co.*, 247 U.S. 426, 433-4; *Powers-Kennedy Contracting Corporation, et al. v. Concrete Mixing and Conveying Co.*, 282 U.S. 175, 180, 186; *Electric Cable Joint Co. v. Brooklyn Edison*, 292 U.S. 69, 79; *Concrete Appliances Co., et al. v. Gomery et al.*, 269 U.S. 177; *American Road Machine Co. v. Pennock and Sharp Company*, 164 U.S. 26; all to the effect that no invention is involved in assembling old elements where the result is only that which arises from the well-known operation of each.

3. Because the courts below have failed to give proper consideration to the public interest in holding claims 6, 7 and 8 of the patent in suit valid and in construing the claims as though they were directed to a grinding machine combination, whereas in fact they are not to such a combination, either directly or indirectly, and the public interest becomes paramount, *Mercoid Corporation v. Mid-Continent Investment Co.*, 320 U.S. 661, 665; *General Electric Co. v. Wabash Appliance Corporation*, 304 U.S. 364, 369; *United Carbon Company v. Binney & Smith Co.*, 317 U.S. 228, 232.

4. Because Petitioner does not seek a retrial of the facts but merely a proper application of the law to the facts, *The Williams Manufacturing Co. v. United Shoe Machinery Corp.*, 316 U.S. 364, 365.

5. Because the validity of an unexpired patent is of public importance, *Sinclair & Carroll Co. v. Interchemical Corp.*, 65 S. Ct. 1143, 1145; 325 U.S. 327.

Wherefore, your Petitioner respectfully prays that a writ of certiorari be issued under the seal of this Court, directed to the United States Circut Court of Appeals

for the Seventh Circuit, commanding the said Court to certify and send to this Court, on a day to be designated, a full and complete transcript of the record and all proceedings of the Circuit Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court, that the judgment of the Circuit Court of Appeals be reversed, and that Petitioner be granted such other and further relief as may seem proper.

JOHN W. MICHAEL,
GERRIT D. FOSTER,
Counsel for Petitioner.

Milwaukee, Wisconsin,
May 15, 1946.